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RE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/100,934 06/22/98 STOUT

W 9278

EXAMINER

TM02/0420

CLIFFORD W. BROWNING
WOODARD EMHARDT NAUGHTON MORIARTY
& MCNETT
111 MONUMENT CIRCLE, SUITE 3700
INDIANAPOLIS IN 46204-5137

PARDOL

ART UNIT

PAPER NUMBER

2171

DATE MAILED:

04/20/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

RE

Office Action Summary

Application No.
09/100,934

Applicant
Stout

Examiner
Thuy Pardo

Group Art Unit
2171



☒ Responsive to communication(s) filed on Apr 2, 1901

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-4 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-4 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. Applicant's Declaration and Reconsideration filed on July 20, 2000 in response to Examiner's Office Action has been reviewed.
2. Claims 1-4 are presented for examination.
3. The text of those sections of Title 35, U.S. Code § 103 not included in this action can be found in a prior Office Action.
4. Claims 1 and 3 are rejected under 35 U.S.C. § 102(e) as being anticipated by **Adamchick** patent no. 5,761,668, claim 2 is rejected under 35 U.S.C. § 103 as being unpatentable over **Adamchick** patent no. 5,761,668, and claim 4 is rejected under 35 U.S.C. § 103 as being unpatentable over **Adamchick** patent no. 5,761,668, in view of **Dickens** patent no. 5,806,063.
5. **Adamchick** and **Dickens** were cited as prior art in the last office action. The rejections are respectfully maintained and incorporated by reference as set forth in the last office action.

Response to Arguments

6. Declaration under 37 C.F.R. 1.131

The nexus between the exhibit of the affidavit and the claimed invention is missing. The exhibit demonstrates an abstract conception for some of the elements of the claims, but clearly does not demonstrate elements such as those of claim 1:

a computer readable memory storage medium,
data files, or
a central processing unit.

An analysis of missing elements for other claims is similar. If the claims closely echoed only the limitations demonstrated, they would be rejected under 35 U.S.C. § 101.

Hence it is considered that Adamchick is prior art, and the priority date of the invention is that of the application, 22 June 1998.

7. 102(e) rejection:

Applicant fails to recognize to the level of skill in the art. In particular, in claim 1, a format is claimed which enables an arithmetic, and is the same as that taught by Adamchick. Clearly the same capability follows from the common format and would be recognized by one of ordinary skill. Further, the point of data file is to use the dates for calculations.

The seven digits from claim 3 merely uses the standard year format, 1999, 2000, 2001, ...etc, which provides for no year compressions. The seven digit Julian date is known in Adamchick [col. 4, lines 28-32].

8. Applicant's Request for Consideration filed on November 29, 2000. The exhibit is, as stated in the Declaration, an act of conception but not a reduction to practice. Applicant relies on filing of the application for constructive reduction to practice on June 22, 1998. The claim of diligence is not complete (see MPEP 2138.06), "An applicant must account for the entire period during which

diligence is required. *Gould v. Shawlow*, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough); *In re Harry*, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter “was diligently reduced to practice” is not showing but a mere pleading)”. In particular, the entire initial period must start prior March 08, 1996 and show diligence up to the part of reduction to practice, June 22, 1998. Dates must be established for items such as the effects of the surgery.

9. Applicant's Declaration and Response filed on February 06, 2001. The exhibit is, as stated in the Declaration, an act of contacting with several companies, organization, and government agencies but not a reduction of the complete invention to practice, and does not demonstrate diligence in that regard. The submitted Declaration is addressed to offer for use or sale, not to reduction of invention to practice. The claim of diligence is not complete (see MPEP 2138.06), “An applicant must account for the entire period during which diligence is required. *Gould v. Shawlow*, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough); *In re Harry*, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter “was diligently reduced to practice” is not showing but a mere pleading)”. In particular, the entire initial period must start prior March 08, 1996 and show diligence up to the part of reduction of the complete invention to practice, June 22, 1998. Dates must be established for items such as the effects of the surgery.

10. Applicant's arguments have been fully considered but they are not deemed to be persuasive.

11. This is a continued prosecution application of applicant's earlier Application No. 09/100,934. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy Pardo, whose telephone number is (703) 305-1091. The examiner can normally be reached Monday through Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas G. Black, can be reached at (703) 305-9707. The fax phone number for this Group is (703) 3085403.

Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

13. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications; please mark "EXPEDITED
PROCEDURE")

Or:

(703) 308-5359, (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA.,
Sixth Floor (Receptionist).



Thuy Pardo
April 19, 2001



WAYNE AMSBURY
PRIMARY PATENT EXAMINER